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> "Bicycle computers also exist which have output ports enabling the device to be interfaced to a commercially available personal computer. The invention, "BICYCLE COMPUTER WITH MEMORY AND MEANS FOR COMPARING PRESENT AND PAST PERFORMANCE IN REAL TIME," disclosed in U.S. Patent 5,335,188 to Brisson, for example, discloses a device for monitoring and comparing present, past and ideal performance on an exercise machine such as a bicycle. The system operates under a predetermined set of user-controlled instructions, to store a set of performance data in memory, which can then be compared against a stored, user selected performance data. Comparisons among these various data sets may then be displayed.
>
> The exercise computer of Brisson includes a connector (65) for linking to an external computer, but the capabilities involved are extremely limited. In one example given, data in the memory of the computer itself may be transmitted to the external computer for "safekeeping," then transferred back to the cycle computer at a later time. The specified purpose is to ensure that the data are not lost should the memory suffer from a power failure, should the cycle computer be stolen. Alternatively, if the user rides on many different routes, the cycle computer may not have enough memory to save all ride data, in which case the connector (65) may be used to transfer a larger number of pace files to an external computer such as a PC. Thus, according to the '188 patent, although a computer interface is provided, it is essentially limited in function to that of a memory expansion port." (Applicant's specification, page 2, line 11 to page 3, line 11.)

In the Office Action to which this response is directed, Paper No. 3, the Examiner concedes that Brisson fails to specifically disclose a recording unit incorporating a GPS satellite receiver (Office Action, page 3). However, in the Examiner's view, Masumoto discloses "in an analogous art" a global position system for use with a vehicle, such that it would have bene obvious to one of the skill in the art, according to the Examiner, to <u>modify the system of Brisson</u> with that of Masumoto "to better position the vehicle to be capable of producing data." Applicant respectfully disagrees. In rejecting claims under 35 U.S.C. §103, it is incumbent upon the

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Examiner to establish a factual basis to support the legal conclusion of obviousness. See In Re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 5569, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. There must be something in the prior art that suggested the combination of these particular prior art devices and processes other than the hindsight gained from knowledge that the inventor choose to combine these particular things in this particular way. Uniroyal Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988). These showings by the Examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In Re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992).

In this case, it is clearly apparent that Brisson contains no disclosure whatsoever as to the acquisition, development or use of GPS data. This is apart from the fact that, at least according to Applicant's characterization, that the link between the mobile unit of Brisson and the external computer is used only as a memory expansion facility, and not to provide the types of capabilities set forth and claimed by Applicant. The Masumoto patent, on the other hand, resides in a technique whereby a global positioning system within a vehicle may output "correct" position data based upon relative altitude even when the receiving means is only operative in

a two-dimensional position measurement mode (column 2, lines 60-69). Masumoto is entirely silent as to the need for, or use of, a link between a mobile data-acquisition capability and stationary computer for later review and analysis, since in all embodiments of Masumoto, the navigation system is apparently entirely self-contained within a vehicle such as an automobile (column 4, lines 12-17 and lines 47-50). And, of course, Masumoto is entirely unrelated to Applicant's sports-related fields of use.

Accordingly, one of skill in the art of sports monitoring equipment, given Applicant's problem of facilitating a later review of a route taken by a user on a stationary computer through an appropriate interface, would never consult Masumoto, or any of the other numerous patents regarding self-contained GPS receivers in vehicles such as automobiles, to solve Applicant's problem. As such, it is Applicant's position that the Examiner has failed to establish a *prima facie* case of obviousness by virtue of the Brisson/Masumoto combination, and that such rejection be withdrawn. Additionally, the Examiner's argument that it would have been "obvious" to modify Brisson with Masumoto "to better position the vehicle to be capable of producing data," does not appear to make sense to Applicant, since, presumably, the mobile sports data-gathering unit according to Applicant is, at all times, capable of "producing data," as is the stationary computer to which it is later attached for subsequent analysis and review.

As to independent claims 19 and 22, it is noted that both of these include apparatus or methods for determining the speed and

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location associated with various points along a route taken by an individual engaged in a sports-related activity, and displaying the speed and location information along the route. Independent claim 22, being a method claim, includes the step of "downloading the speed and location of the individual to a computer having a display device so as to enable such display for analysis by the user." In this regard, the Examiner states that "Brisson discloses all the claim [sic] as discussed and further discloses a speedometer for determining the speed as shown in figure." (Office Action, page 3.) However, whether Brisson discloses a speedometer is immaterial to the combination of elements set forth in Applicant's claims, which are not met by the combination of Brisson and Masumoto. In other words, with respect to independent claims 19 and 22, even if Brisson and Masumoto were to be combined, which Applicant believes is inappropriate, the subject matter of claims 19-23 would not be the result, since nowhere in the Brisson/Masumoto combination does a comparison of position and speed take place for later review on the display device.

Based upon the foregoing comments, Applicant believes all claims, as amended pursuant to the Preliminary Amendment signed May 19, 1998, are in condition for allowance, and notice to that affect is solicited at this time. Questions regarding this application should be directed to the undersigned attorney at the telephone and facsimile numbers provided.

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Respectfully submitted,

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Date: Nov. 16, 1998

CERTIFICATE OF MAILING

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231, on the date shown below.

Date: 11/16/98

Sheryl L. Hammer

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